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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,212	01/12/2004	Shubh D. Sharma	70025-US-22196	1728

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EXAMINER

GUPTA, ANISH

ART UNIT

PAPER NUMBER

1654

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/756,212

Applicant(s)

SHARMA ET AL.

Examiner

Anish Gupta

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) 3, 4, 7, 10-12 and 14-32 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 5-9 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8-9-04, 1-12-04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 10, 12, 14, 33-34, where the polypeptide comprises the sequence Ser-Phe-Arg-Trp and the species 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-NH₂ in the reply filed on 11-6-06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

A search was conducted for the species 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-NH₂ and extended to other peptides having the sequence Ser-Phe-Arg-Trp. 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-NH₂, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-Ala-NH₂, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-Asp-Phe-NH₂, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-Asp-NH₂, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-MeTrp-NH₂, heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-MeTrp-NH₂, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-tryptamide, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Nme-tryptamide, 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-alpha-Me-Tryptamide were found to be free of the prior art. The search was then extended to the linking claims 1-9, 13, and prior art was found that anticipate the claims. Since prior art was found that anticipated the Markush type claims 1, 9 and 13, search was not extended to Markush type claim 11. The MPEP states "On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species." See MPEP 803.02. Thus, the search

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was not extended to claim 3-4, 7, 11. Furthermore, Since claims 10, 12, 14 were examined in part, only those corresponding to the sequence having Ser-Phe-Arg-Trp, these claims have been withdrawn from consideration. Claims 3-4, 7, 10-12, 14 and 15-32 have been withdrawn from consideration as corresponding to non-elected Groups II-IX.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –


(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5, 6-9 and 13 rejected under 35 U.S.C. 102(b) as being anticipated by Sharma et al. (WO01/13112).

The claims are drawn to peptides of the formula S1-S2 –S3-S4-S5.

The reference teaches the peptide Heptanoyl-Ser(Bzl)-D-Phe(2-Cl)-L-Arg-L-Trp-L-Cys-NH₂ (see page 46, compound No. PL-1915). This meets the limitation of claim 1 where S1 is heptanoyl, S2 is Ser(Bzl), S3 is D-Phe-(2-Cl), S4 is L-Arg, S5 is the dipeptide L-Trp-L-Cys-NH₂. The reference also teaches the peptide Hpetanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-L-Trp-Cys-NH₂ (see page 47, compound number 1949). This compound meets the limitation of claim 9 and 13.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (571)272-0965. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can normally be reached on (571) 272-0562. The fax phone number of this group is (571)-273-8300.


ANISH GUPTA
PRIMARY EXAMINER